



IMAGE

P21831.A06

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Katsuji SHIBATA et al.

Group Art Unit: 1714

Appl. No. : 10/022,342

Examiner: Wyrozebski Lee

Filed : December 20, 2001

For : Decomposition Treatment Liquid for Cured Unsaturated Polyester Resin,
Method for Treating Cured Unsaturated Polyester Resin by Use of the Treating
Liquid, and Method for Separating Composite Material

SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

Pursuant to 37 C.F.R. §1.97-§1.98 and 37 C.F.R. §1.56, Applicants call the attention of
the Examiner to the following information:

A Chinese Office Action, issued on August 29, 2003 for related Chinese Application No.
01144811.3, in which the following documents were cited:

U.S. Patent No. 4,044,046 to KONDO et al., issued on August 23, 1977; and

U.S. Patent No. 5,840,772 to PETERS et al., November 24, 1998.

Applicants note that the above-mentioned documents were previously cited in an
Information Disclosure Statement filed in the instant application on June 12, 2002, prior to the
issuance of the Office Action of September 25, 2003, and thus, copies of the same are not
attached hereto. However, a copy of an English language translation of the Chinese Office
Action is attached hereto.

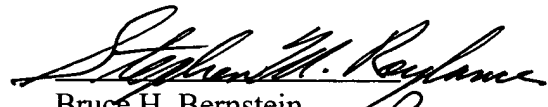
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Applicants respectfully request that the Examiner consider the attached Chinese Office Action.

Applicants note that no new information is being brought to the Examiner's attention, and thus, no fee is necessary to ensure consideration of this statement.

Should the Examiner have any questions, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted.
Katsuji SHIBATA et al.


Bruce H. Bernstein
Reg. No. 29,027
Reg No 31,296

November 17, 2003
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THE PATENT OFFICE OF THE PEOPLE'S REPUBLIC OF CHINA

Applicant	Hitachi Chemical Company Ltd.	Issue Date Aug 29, 2003
Agent	Dragon International Patent Office	
Application No.	01144811.3	
Title of Invention	Decomposition Treatment Liquid for Cured Unsaturated Polyester Resin, Method for Treating Cured Unsaturated Polyester Resin by Use of the Treatment Liquid, and Method for Separating	

THE NOTIFICATION OF THE FIRST OFFICE ACTION

1. ☒ In accordance with the Request for substantive examination on September 13, 2002, the examiner has made the examination on the above patent application based on the provision in paragraph 1, Article 35 of the PRC Patent Law.

☐ The Patent Office itself has decided to make a substantive examination for the above cited patent application based on the provision in paragraph 2, Article 35 of the PRC Patent Law.

2. ☒ The applicant requested to designate the filing date of

December 22, 2000 in the Patent Office of JP as the priority date;
_____ in the Patent Office of _____ as the priority date;
_____ in the Patent Office of _____ as the priority date;

☒ with the submission of certified copy of priority Document(s).

☐ no certified copy of priority document has been received heretofore and, according to the provisions of Article 30 of the PRC Patent Law, it is deemed that no priority right has been requested.

☐ the present application is PCT application.

3. ☐ The applicant submitted the amended text is not in conformity with Article 33 of Chinese Patent Law and is unacceptable:

☐ the amended text submitted according to Article 28 or 41 of the PCT.

4. ☒ Examination is made based on the Chinese translation of the original filing document.

☐ Examination is made based on the following documentations.

☐ page(s) _____ of description based on the Chinese translation of the original filing document.

Page(s) _____ of description based on the Chinese translation of attachment of international Preliminary Examination Report.

Page(s) _____ of description based on the amended documents that are submitted in accordance with Article 28 or 41 of the PCT.

Page(s) _____ of description based on the amended documents that are submitted in

accordance with Article 51 of the Chinese Patent Law.

- ☐ Item(s) _____ of claims based on the Chinese translation of the original filing document.

Item(s) _____ of claims based on the Chinese translation of the amended documents that are submitted in accordance with Article 19 of the PCT.

Item(s) _____ of claims based on the Chinese translation of attachment of international Preliminary Examination Report.

Item(s) _____ of claims based on the amended documents that are submitted in accordance with Article 28 or 41 of the PCT.

Page(s) _____ of claims based on the amended documents that are submitted in accordance with Article 51 of the Chinese Patent Law.

- ☐ page(s) _____ of drawings based on the Chinese translation of the original filing document.

Page(s) _____ of drawings based on the Chinese translation of attachment of international Preliminary Examination Report.

Page(s) _____ of drawings based on the amended documents that are submitted in accordance with Article 28 or 41 of the PCT.

Page(s) _____ of drawings based on the amended documents that are submitted in accordance with Article 51 of the Chinese Patent Law.

5. ☐ The notification is made without conducting the search for the patent ability.

☐ The notification is made under the search for the patent ability.

☒ The following reference materials have been cited in this notification (their serial numbers will be referred to in the following procedure);

Serial Number	Number or Title of Reference Material	Publication Date (or Filing Date of A Conflict Patent Application)
1	US5840772A	Nov 24, 1998
2	US4044046A	Aug 23, 1977

6. The conclusion of the examination;

- ☐ In regard to the description;

☐ The subject matter of the present application is not accepted based on the Article 5 of the PRC Patent Law.

☐ The presentation of the description is not in conformity with the provision of Rule 26, Paragraph 3 of the Implementing Regulations of PRC Patent Law.

☐ The presentation of the description is not in conformity with the provision of Rule 18 of the Implementing Regulations of PRC Patent Law.

☐ The presentation of the abstract is not in conformity with Paragraph 1 of Rule 24 of the Implementing Regulations of PRC Patent Law.

- ☒ In regard to the Claims:

☐ Claims _____ can not be allowed beyond the scope of the protection based on the Article 25 of the PRC Patent Law.

☐ Claims _____ do not belong to the definition of invention based on the provision of paragraph 1, Rule 2 of the Implementing Regulations of the PRC Patent Law.

☒ Claims 1-4, 9-11 can not be allowed owing to lack of novelty based on the provision of paragraph 2, Article 22 of PRC Patent Law.

☒ Claims 6-8, 12-15, 17-21 can not be allowed owing to lack of inventiveness based on the provision of paragraph 3, Article 22 of PRC Patent Law.

☐ Claims _____ can not be allowed owing to lack of practical applicability based on the provision of paragraph 4, Article 22 of PRC Patent Law.

☐ Claims _____ can not be allowed based on the provision of paragraph 4, Article 26 of PRC Patent Law.

☐ Claims _____ can not be allowed based on the provision of paragraph 1, Article 31 of PRC Patent Law.

☒ Claims 4-8, 12, 13, 17-21 can not be allowed based on the provision of Rules 20 to 23 of the Implementing Regulations of the PRC Patent Law.

☐ Claims _____ can not be allowed based on the provision of Article 9 of PRC Patent Law.

☐ Claims _____ can not be allowed based on the provision of paragraph 1, Rule 12 of the Implementing Regulations of the PRC Patent Law.

The explanation of the conclusion is given in the attachment sheet in details

7. According to the above conclusion, it is considered that

☐ the applicant should amend the application documents based on the request in the Attachment Sheet.

☒ the applicant should state the reason on which the application can be accepted and amend the part that is indicated not to be conformity with the requirement, otherwise the application will be rejected.

☐ No subject matter in the application is accepted, said application will be rejected if the applicant does not make a statement or fail to make a statement.

☐ the application will be rejected if amendment of documents submitted by applicant goes beyond the scope of patent protection

8. The applicant is drawn attention to that

(1) In accordance with the provisions of Article 37 of the Chinese Patent Law, the applicant shall submit the observation within FOUR months from the date of receiving this notification. If the applicant, without any justified reason, fails to reply within the time limit, the application shall be deemed to have been withdrawn.

(2) The applicant shall make amendments to what is not in conformity with the provisions in the text of this notification. The amended text shall be furnished in duplicate. The formality of the document should be in conformity with the relative provisions of the Guidebook for Examination.

(3) The applicant and/or his attorney could not go to the PRC Patent Office to meet the examiner if no appointment is made.

(4) **Any response and/or amended specification must be mailed or sent by hand to the receiving Department of the PRC Patent Office. Any documents that are not sent to the Receiving Department do not have legal force.**

9. The text of notification embraces 2 page(s), along with the enclosures herein:

☒ 2 copy of the cited references is enclosed in page of 18.

Notification of The First Office Action

The present invention relates to a decomposition treatment liquid for a cured unsaturated polyester resin, a method for treating a cured unsaturated polyester resin by the use of the treatment liquid, and a method for separating a composite material. The following comments are provided after substantive examination:

Claim 1 asks for protection of a decomposition treatment liquid for a cured unsaturated polyester resin, comprising a phosphoric acid-type compound or salt thereof and an organic solvent. Turning to Document 1 (US 5,840,772A), this document discloses in EXAMPLES 3, 6 and 10 three kinds of composition, which comprising potassium phosphate and various organic solvents, phosphoric acid and various organic solvents or phosphate ester and various organic solvents respectively. This kind of decomposition treatment liquid is used for separating coatings from the base plastic. It can be understood that the technical problem solved in document 1 aiming at separating coatings from the base plastic is the same as that in the present application aiming at separating the fillers from the resin, and the technical effects obtained by the two technical solutions are the same. Therefore, claim 1 is rejected over document 1 under A 22.2 of the Patent Law of China (PLC) as being lacking of novelty.

For the same reason mentioned above, claims 2, 3 and 4 are rejected under A 22.2 of the Patent Law of China (PLC) as being lacking of novelty.

The dependent claims 6-8 further define the decomposition treatment liquid for a cured unsaturated polyester resin by characterizing the organic solvent, more specifically, claim 6 says that the organic solvent includes an alcohol-based solvent, claim 7 says that the organic solvent has a boiling point of 170°C or higher, and claim 8 says that the organic solvent includes an alcohol based solvent having a boiling point of 170°C or higher. Document 2

(US 4044046A) (column 1, line 48-60) discloses a method for recovering polyol from polyurethane which comprises dissolving a polyurethane in an aliphatic diol having a boiling point of above 180°C. For a person skilled in the art, it is easy to combine document 1 and document 2 to obtain the technical solutions in claims 6-8 since the technical problem solved in document 2 is also the same as that in the present application, and the technical effects obtained by the two technical solutions are the same, Therefore, claim 6-8 are rejected over documents 1 and 2 under A 22.3 of the Patent Law of China (PLC) as being lacking of inventive steps.

Claim 9 asks for protection of a method for treating a cured unsaturated polyester resin, comprising a step of decomposing or dissolving the cured unsaturated polyester resin using the treatment liquid according to any one of claims 1 to 8. However, this technical solution has been disclosed in document 1 (examples 3, 6 and 10). Therefore, claim 9 is rejected over document 1 under A 22.2 of the Patent Law of China (PLC) as being lacking of novelty.

Claims 10 and 11 characterize the treatment conditions as being at 250 °C or lower and under atmospheric pressure. However, document 1 discloses treating unsaturated polyester resins including PET by using the treatment liquid at about 80°C and under atmospheric pressure. Therefore, claims 10 and 11 are rejected over document 1 under A 22.2 of the Patent Law of China (PLC) as being lacking of novelty.

Claim 12 asks for protection of a method for separating the composite material containing a filler and a cured unsaturated polyester resin. This process is a kind of prior art technique, which is a common knowledge to those skilled in the art, while the treatment liquid is the same as that of claim 1. Therefore, claim 12 is rejected over document 1 under A 22.3 of the Patent Law of China (PLC) as being lacking of inventive steps.

Claims 14, 15 and 17-21 actually define the treatment liquid. Since

documents 1 and 2 disclose all these technical features characterizing claims 14, 15 and 17-21, these claims are rejected over documents 1 and 2 under A 22.3 of the Patent Law of China (PLC) as being lacking of inventive steps.

Claim 13 asks for the same protection scope as that of claim 2, which leads to the uncompendiousness. It is suggested that deleting claim 13 or submitting a more clearly translation of claim 13 to fulfill the requirement of R21.1 of the Implementing Regulations of the PLC.

Claims 5-8, 18-21 are objected to in that multiple dependent claims could no be cited by another multiple dependent claims. In addition, claims 4-8 and 17-21 are objected to in that they do not refer to the preceding claims in the alternative way. Therefore, claims 4-8 and 17-21 are not in conformity with R23.2 of the Implementing Regulations of the PLC.

Based on the above statement, the present application cannot be granted patent right unless the applicant amends the present application and overcome the defects pointed in this Office Action under Article 33 of Patent Law of China.